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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,042	01/20/2004	Kami L. Bechyne	KCC 4778.2 (K-C 17, 571.2	1196
321	7590	12/22/2005	EXAMINER	
SENNIGER POWERS ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tuta

Office Action Summary	Application No.	Applicant(s)	
	10/761,042	BECHYNE ET AL.	
	Examiner	Art Unit	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as obvious over Jones (Patent no. 6,059,100) in view of Barrow et al (Patent no. 6,115,997). A feminine hygiene disposal package 10 is disclosed for carrying pads comprising a receptacle 12 having an interior 14 in which a plurality of disposable containers 20 are located. The difference between the claimed subject matter and Jones resides in package 10 carrying a supply of pads in the receptacle.

Barrow et al discloses that it is well known to those skilled in this art to supply disposable feminine hygiene pads in a container that not only serves to carrying a new pad but also serves to hold the used pad, see col. 1, lines 23-30. It would have been obvious to one of ordinary skill in the art to modify the system of Jones by incorporating a supply of pads in the containers in view of the teaching of Barrow et al, in order to obviate the need to have a separate individual packages, provide the pads associated together in a single receptacle and economize material by using the same container twice.

To the extent that Jones does not employ such a press-fit closure, Official Notice is taken for the use of press fit members as a notoriously old and well known means for closing a bag. It would have been obvious to one of ordinary skill in the art to employ press fit members in view of Official Notice, order to provide a convenient means for closing the bag.

As to claim 2, the manner in which the blank is folded to form the bag is a product by process type of limitation. A "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17(footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90; and *In re Marosi et al*, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and the an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it which is recited in the claim. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985), M.P.E.P. § 2113.

As to claims 3 and 4, an opaque material is contemplated in col. 3, line 62 in Jones. To employ a plastic film at least partially opaque would have been obvious for the reason of concealing the contents of the bag.

As to claim 5, each of the feminine hygiene products is sealed in their own container.

Response to Arguments

3. Applicant's arguments filed October 14, 2005 have been fully considered but they are not persuasive. Applicant argues Jones lacks any disclosure or suggestion for placing feminine hygiene pads in the main container 12. While Jones may not provide a disclosure of feminine pads in the container, applicant is not as convincing that Jones lacks any "suggestion" for placing pads in the container. Col. 4, lines 60-67 explicitly points out "**numerous** (emphasis added) modifications and changes will be readily occur to those skilled in the art" as it is not Jones' intent to "limit the invention to the **exact** (emphasis also added) construction and operation shown and described". While perhaps not explicitly disclosing feminine hygiene pads in the main container, there is substantial evidence showing a recognition by Jones that the invention may be modified to include relevant modifications and changes as would be recognized by those skilled in the art. That "**all** suitable medications and equivalents may be resorted to, falling with

the scope of the invention". And what is that scope of the main invention? As briefly summarized in claim 1, a feminine disposal hygiene system comprising; 1) a main container, 2) a plurality of disposable containers separately coupled to one another, 3) each disposable container having an interior to hold a used feminine hygiene product, and 4) each of the disposable container adapted to be sealed in a manner to prevent environmental communication between the chambered interior of the disposable container and the surrounding environment (a good definition of hygienic sealing). The only difference between Jones and the invention of claim 1 resides in "a supply of pads in the receptacle" 12 of Jones and "the receptacle having a reclosable closure for closing the opening, said closure being closed for carrying the pads in hygienic condition".

There is absolutely nothing within the disclosure of Jones that fails to suggest that merely modifying the receptacle 12 to include a supply of pads is beyond the purview of the disclosure. In fact, since the inventive concept of Jones is for the disposal of a plurality of feminine hygienic products the implication is that somewhere in association with Jones' system, e.g., in ones' purse or on ones' person, there is provided a supply of pads carried or provided in some manner. Otherwise what would be the point. It implicit within Jones that a supply of pads are associated with the system. In as much as applicant defines the presently claimed subject matter over Jones, it would have been obvious to one of ordinary skill in the art to include a supply of pads in the receptacle 12 of Jones as a matter of common sense. If for nothing else to have the new pads readily in association with the disposal system. Such a modification would have been within the level of ordinary skill involving no special degree of expertise or knowledge.

It is also pointed out nothing in Jones states what one does with the disposable containers 20 once they are hygienically sealed with the pads. Situations could exist, such as with camping, hiking or other circumstances, where the disposable containers could be placed back into the receptacle 12 until such time when one can properly dispose of the products. This would clearly suggest applicant's invention in as much as is claimed. Depending upon what the users does, nowhere does Jones fail to envision a plurality of pads used with her system.

Burrow et al is cited demonstrating the aforementioned properties. Particularly where it is well known to those skilled in the art to provide feminine hygienic pads in association with the a

disposable container. Burrow et al states this wrapper may optionally include a resealable tab with the feminine hygienic product to receive the used product. Hence, Burrow et al suggests providing a supply of pads in the disposable containers as is well recognized by those skilled in this art. As such a supply of pads is provided by what the prior art (Jones and Burrow et al) taken as a whole suggests. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Accordingly, the rejection is believed to be well founded.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion for the combination in providing the supply of pads in a single hygienic container 12 of Jones is so that the products may be associated together in a single system as mentioned previously. Also, Burrow et al suggest providing a plurality pads in the container 12 of Jones so that each feminine hygienic product may be packaged in the disposable container 20. In either instance, applicant's refusal to acknowledge a plurality of individual pads is suggested by the prior art represents a rather myopic view of the relevant teachings and pertinent concepts as would have been recognized by the skilled artisan. In any event, the Examiner is not convinced that merely providing a plurality of feminine hygienic products in a disposal system for feminine hygienic products would have involved an inventive concept to one of ordinary skill in the art at the time the invention was made.

As to claims 2-5, applicant argues patentability based on the dependency from claim 1. The failure to address specific distinctions is a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them. This is consistent with the practice of the Court of Appeals for the Federal Circuit indicated in such cases as *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); *In re*

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Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); and In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei
Primary Examiner
Art Unit 3728

dtf
August 8, 2005